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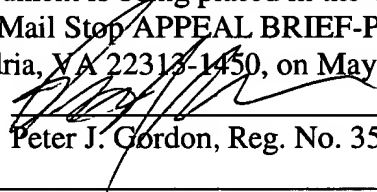
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: McKain *et al.*  
Serial No: 08/932,784  
Filed: September 18, 1997  
For: MOTION PICTURE RECORDING DEVICE USING DIGITAL.  
COMPUTER-READABLE NON-LINEAR MEDIA  
Examiner: H.T. Nguyen  
Art Unit: 2615

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Mail Stop APPEAL BRIEF-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 13, 2003.

  
Peter J. Gordon, Reg. No. 35,164

Mail Stop APPEAL BRIEF-PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPLICANT'S REPLY BRIEF UNDER 37 C.F.R. §1.193(b)(1)**

Sir:

This reply brief, submitted in triplicate, is submitted under 37 C.F.R. §1.193(b)(1). No fee is required. An Oral Hearing was already requested.

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### **I. Related Appeals and Interferences**

Applicant hereby updates the status of "Related Appeals and Interferences", listed in Section II of Applicant's Brief, as follows:

U.S. Patent Application Serial No. 08/932,993 (the "Related Application") has related subject matter and is currently subject to a Final Office Action dated March 13, 2003, including a rejection based on U.S. Patent 5,579,239 ("Freeman"), U.S. Patent 5,537,157 (the "'157 Patent") and Japanese Patent Application 3-314435 with publication number 5-153448, which are discussed in the Appeal Brief. Concurrently with this Reply Brief, Applicant is filing a Notice of Appeal in the Related Application.

### **II. New Issues Raised in the Examiner's Answer**

The Examiner's Answer newly asserts, to support the proposed combination underlying the rejection under 35 U.S.C. §103, that such a combination would "provide advantages to the user in handling capturing desired motion pictures . . . ." This Reply Brief is being filed to address this new issue raised by the Examiner's Answer.

### **III. Argument**

Based on precedent from the Court of Appeals for the Federal Circuit, "it is fundamental that rejections under 35 U.S.C. §103 must be based on *evidence* comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983, emphasis added), emphasis added. In particular, since most obviousness rejections involve a combination of references, precedent also requires a reason to combine references. This reason "must be based on *objective evidence* of record." *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002, emphasis added). "[T]his factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority." *in re Lee*, at 1434.

A. There is no evidence in the record to support a factual finding that one of ordinary skill in the art would have recognized, at the time the invention was made, that it was desirable to combine, in a housing sized to be portable for use by an individual, a motion picture camera, a digital computer-readable and writable random-access medium to store the sequence of digital still images in a computer-readable file format, and a

system for specifying a sequence of segments of the sequence of digital still images to provide "advantages to the user in handling capturing desired motion pictures."

Both of the rejections are based on a combination of references and Osamu. The Examiner's Answer newly asserts, to support the proposed combination, that such a combination would "provide advantages to the user in handling capturing desired motion pictures . . . ." Examiner's Answer, page 9, last two lines. This assertion is not supported by any evidence *from the prior art* that one of ordinary skill in the art, at the time the invention was made, would have recognized that such advantages could be successfully obtained.

Because the record lacks evidence required to support the findings of fact on which the rejection is based, it cannot be held that the references relied upon by the Examiner would have suggested to one of ordinary skill in the art at the time the invention was made "a housing sized to be portable for use by an individual; a motion picture camera mounted in the housing. . . ; . . . a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format," and a system "within the housing for specifying [or defining] a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium," as claimed in the independent claims 1, 9 and 23.

#### IV. CONCLUSION

For the foregoing reasons, in addition to those already provided in the Applicant's Appeal Brief, the final rejection should be reversed.

Should any questions arise concerning this appeal, please call the Applicant's representative listed below.

Respectfully submitted,

By 

Peter J. Gordon

Registration No. 35,164

Attorney for Applicant(s)

Avid Technology, Inc.

One Park West

Tewksbury, Massachusetts 01876

Tel. No.: 978.640.3011

Date: May 13, 2003

Docket Number: A1995001C2



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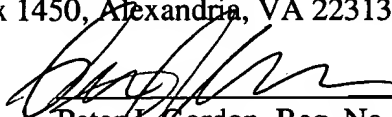
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**TRANSMITTAL LETTER**

Transmitted herewith for filing in the above-entitled patent application is an Applicant's Reply Brief under 37 CFR §1.193(b)(1), submitted in triplicate.

No fee is required. The Commissioner is hereby authorized to charge **Deposit Account No. 50-0876** for any fees which may be required or credit any overpayment. A duplicate copy of the sheet is enclosed.

Dated: May 13, 2003

Respectfully submitted,



Peter J. Gordon  
Registration No. 35,164  
Attorney for Applicant(s)  
Avid Technology, Inc.  
One Park West  
Tewksbury, Massachusetts 01876  
Tel. 978-640-3011